



MS APPEAL BRIEF - PATENTS
PATENT
2565-0175P

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

Before the Board of Appeals

Tomohisa YAMAGUCHI

Appeal No.:

RECEIVED

AUG 30 2004

Appl. No.: 09/337,500

Group: 2155

Technology Center 2100

Filed: June 22, 1999

Examiner: Thu Ha T NGUYEN

Conf.: 9078

For: A SYSTEM OF DYNAMIC MODULE CONFIGURATION
AND A METHOD THEREOF

REPLY BRIEF TRANSMITTAL FORM

MS APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

August 25, 2004

Sir:

Transmitted herewith is a Reply Brief (in triplicate) on behalf of the appellants in connection with the above-identified application.

☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

The Examiner's Answer was mailed on June 28, 2004.

☐ An extension of time under 37 C.F.R. § 1.136(b) to _____ was requested on _____ and was approved on _____.

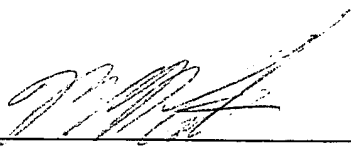
☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this sheet is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

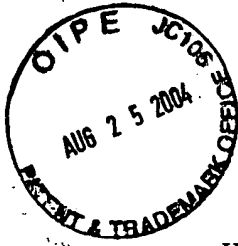
By


Michael R. Cammarata, #39,491

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Attachment(s)



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23

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REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

August 25, 2004

Sir:

In response to the Examiner's Answer dated June 28, 2004, Appellant provides the following reply.

The Appellee argues that the motivation to combine Tock with Domenikos to achieve Appellant's claimed invention relies on the fact that "Tock suggests a system of a request device (i.e. client computer 102) located remotely from an execution device (i.e. server 108) and the execution device having memory to modify the system of request device and execution device located on a network remotely from said memory by Domenikos". See page 14 of the Examiner's Answer.

This alleged motivation by the Appellee is confusing since by stating such the Appellee expressly states Appellant's position that server 108, which the

Appellee alleges corresponds to Appellant's execution device, contains its own memory for storing data to modify the computer 102, which the Appellee alleges corresponds to Appellants claimed request device. Thus, there is no need for a separate memory as suggested by the Appellee.

Further, the Appellee alleges that these features can be combined with Domenikos memory. However, Domenikos memory 46 is contained within a server 14. See page 10, lines 41-60 of Domenikos. Thus, a combination of Tock and Domenikos based on the Appellee's reasoning would actually result in a server 108 and computer 102 of Tock being combined with the server 14 of Domenikos. Therefore, there would be two servers connected to a computer. This is far removed from Appellant's claimed invention providing a separate execution device, request device and memory each of which is remotely located through a network.

Appellant's claimed invention does not utilize two separate servers. Appellant's claimed invention provides three separate devices, a request device, an execution device and memory. Each of these devices are only connected to each by means of a network. Thus, one of ordinary skill in the art would not be motivated to combine Tock and Domenikos in order to achieve Appellant's claimed invention, since the combination would not result in providing the claimed features.

Also, the Appellee states “in response to applicant’s arguments against the references individually, one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merk & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)”.

Appellant reminds the Appellee that in order to formulate a proper obviousness rejection, one of the criteria requires, that all claim limitations must be taught or suggested by the prior art and the asserted modification or combination of prior art must be supported by some teaching, suggestion, or motivation in the applied reference or in knowledge generally available to one skilled in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Appellant in the corresponding Appeal Brief, clearly demonstrated the absence of teachings within the combination of Tock and Domenikos regarding Appellant’s claimed features. Thus, due to the absence of teachings within the references, the Appellee’s obviousness rejection hinges on whether the teachings from the combination of Tock and Domenikos would suggest to one of ordinary skill in the art those features absent from within the teachings of the references that are necessary to achieve Appellant’s claimed invention. As stated above and in the Appeal Brief, the combination of Tock and Domenikos teachings would not suggest Appellant’s claimed invention, but a device

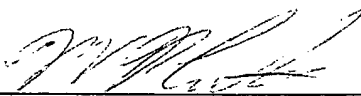
utilizing two servers and configured very different from Appellant's invention. Thus, the combination of Tock and Domenikos would not suggest to one of ordinary skill in the art the features absent from Tock's and Domeniko's teachings in order to achieve Appellant's claimed invention.

Appellant respectfully submits that the combination of Tock and Domenikos fail to teach or suggest the features of Appellant's claimed invention. Accordingly, Appellants respectfully request in view of the arguments provided in Appellants Appeal Brief combined with the Reply Brief, reversal of the rejection to the claims.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. 1.16 or under 37 C.F.R. 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH STEWART KOLASCH & BIRCH, LLP

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